

REMARKS

The Office Action dated March 24, 2004, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto.

Claim 1 has been amended to incorporate the limitations of claim 7, and claim 7 has been canceled. Claims 8 and 10-12 have been amended to depend from claim 1. Applicants submit that the amendments made herein are fully supported in the specification and the drawings as originally filed, and therefore no new matter has been added. Accordingly, claims 1-6 and 8-21 are pending in the present application and are respectfully submitted for consideration.

Amended Claims 1-6 and 8-21 Recite Patentable Subject Matter

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salm et al. (U.S. Patent No. 5,991,396, hereinafter "Salm") in view of Cushman et al. (U.S. Patent No. 6,125,287, hereinafter "Cushman"). Applicants respectfully traverse the rejection.

Amended claim 1 recites a telephone comprising, among other features, a display means for displaying a search result, wherein the display means displays a predetermined number of names from the names found by the searching means, one of the displayed names being in a selection state, the name in the selection state being displayed differently to other names; and when a selection changing operation is received by the operating unit, places another name that is currently being displayed into the selection state. Applicants respectfully submit the cited prior art fails to disclose or suggest at least such feature.

The Office Action characterizes Salm as allegedly showing “a storage unit (55),” “an operating unit (30) including a plurality of numeric keys (32),” “a searching means (33, 34) for searching the storage unit (55),” and “a display means (31) for displaying a search result.” In addition, the Office Action characterizes Cushman as allegedly teaching “in FIG. 1, pressing the OPTions key once changes the current function assignments from ‘MENU,’ ‘1-KEY,’ and ‘INFO’ to ‘EDIT’ only. Pressing the OPTions key for a second time returns the original set of function assignments; ‘MENU,’ ‘1-KEY,’ and ‘INFO’ ‘EDIT’ is no longer visible, and the ‘EDIT’ function is no longer available.”

Clearly, Applicants submit that neither Salm nor Cushman, in combination or alone, disclose or suggest at least a telephone comprising a display means for displaying a search result, wherein the display means displays a predetermined number of names from the names found by the searching means, one of the displayed names being in a selection state, the name in the selection state being displayed differently to other names; and when a selection changing operation is received by the operating unit, places another name that is currently being displayed into the selection state. In particular, it is submitted that the telephone set of Salm and the wireless telephone of Cushman are neither comparable nor analogous to that which is recited in claim 1 of the present application.

To establish a case of *prima facie* obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and *In re Royka*, 490 F.2d 981 (CCPA 1974). As explained above, Salm and Cushman, alone or in combination, do not teach or suggest each feature recited by pending claim 1. Accordingly, for the above provided reasons, Applicants respectfully submit that

pending claim 1 is not rendered obvious under 35 U.S.C. § 103 by Salm and Cushman. Therefore, Applicants submit that claim 1 is allowable.

Furthermore, Applicants respectfully note that claims 2-6 depend from claim 1. Therefore, it is respectfully submitted that claims 2-6 is also allowable for at least the same reasons claim 1 is allowable, as well as for the additional subject matter recited therein.

Applicants respectfully request withdrawal of the rejection.

Claims 7-9, 11, 12, 14-16 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salm in view of Cushman and further in view of Lee et al. (U.S. Patent No. 4,475,013, hereinafter "Lee"). Claim 7 has been canceled without prejudice and therefore the rejection is now moot. Applicants respectfully traverse the rejection with respect to claims 8-9, 11, 12, 14-16 and 20.

Claim 14 recites a telephone comprising, among other features, a display means that (1) displays a predetermined number of names from the name list, one of the displayed names in a selection state, the name in the selection state being displayed differently to other names; (2) updates a display with names from the name list that are not currently displayed, when the operating unit receives a display updating operation; and (3) places another name that is currently being displayed into the selection state, when the operating unit receives a selection changing operation. Applicants submit that the cited prior art fails to disclose or suggest at least such features.

Salm and Cushman are discussed above. The Office Action characterizes Lee as allegedly disclosing that "the name in the selection state being displayed differently

to other names (... see Fig. 1 and ... col. 9, lines 4-8) in order to achieve great attention (see col. 4, line 45)."

Applicants submit that neither Salm, Cushman, nor Lee, taken alone or in combination, disclose or suggest each and every limitation recited in the claims of the present application. Amended Claim 1 of the present invention searches for a name according to one long press of a numeric key (which is a simple user operation) thereby displaying the search result, where one name among the search result is selected according to a user operation and is displayed differently to the other names. As such, the present invention provides a telephone with a very effective aid for a user in searching among names and selecting one name who the user can actually make a phone call to.

In contrast, Lee merely discloses that the display screen 28 highlights the digits by displaying which digit is being transmitted next (column 9, lines 6-8).

Lee does not mention any specific purpose or effect of this structure. The purpose of this structure is clearly to notify people of the fact that an automatic dialing processing is being properly ongoing, by sequentially changing the digits to be highlighted without any user operations. By receiving this notification, a person will have peace of mind knowing that the repertory dialer is properly ongoing.

Accordingly, the present invention is distinguishable over Lee because Lee fails to disclose or suggest at least 1) the selection of an object to be highlighted being performed according to a user operation, 2) the object to be highlighted is one of the names found after the search.

To establish a *prima facie* case of obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and *In re Royka*, 490 F.2d 981 (CCPA 1974). As explained above, Salm, Cushman and Lee, alone or in combination, do not teach or suggest each feature recited by pending claims 1 and 14. Accordingly, for the above provided reasons, Applicants respectfully submit that pending claims 1 and 14 are not rendered obvious under 35 U.S.C. § 103 by Salm, Cushman and Lee, and therefore claims 1 and 14 are allowable.

Furthermore, Applicants respectfully note that claims 8, 9, 11, 12 and 15, 16, 20 depend from claim 1 and 14, respectively. Therefore, it is respectfully submitted that claims 8, 9, 11, 12 and 15, 16, 20 is also allowable for at least the same reasons claims 1 and 14 are allowable, as well as for the additional subject matter recited therein.

Applicants respectfully request withdrawal of the rejection.

Claims 13, 19 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salm in view of Cushman, further in view of Lee, and further in view of Landry et al. (U.S. Patent No. 5,754,602, hereinafter “Landry”). Applicants respectfully traverse the rejection.

As claim 13 depends from claim 1, and claims 19 and 21 depend from claim 14, Applicants submit that each of these claims incorporates the patentable aspects therein, and therefore are allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

Applicants respectfully request withdrawal of the rejection.

Claims 10, 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Salm in view of Cushman, further in view of Lee, and further in view

of Helin et al. (U.S. Patent No. 6,055,439, hereinafter "Helin"). Applicants respectfully traverse the rejection.

As claim 10 depends from claim 1, and claims 17 and 18 depend from claim 14, Applicants submit that each of these claims incorporates the patentable aspects therein, and therefore are allowable for at least the reasons set forth above with respect to the independent claims, as well as for the additional subject matter recited therein.

Applicants respectfully request withdrawal of the rejection.

Conclusion

In view of the above, Applicants respectfully submit that each of claims 1-6 and 8-21 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicants also submit that this subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore, respectfully request that claims 1-6 and 8-21 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together

with any additional fees that may be due with respect to this paper, may be charged to
counsel's Deposit Account No. 01-2300, referencing docket number 101201-00000.

Respectfully submitted,


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Enclosures: Petition for Extension of Time

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